

**REMARKS**

Claims 1-11 are pending in the application. Claims 1, 3, 4, 7, and 10 stand rejected. Claims 11-20 have been added. Claim 1 and the newly added claim 11 are independent claims.

The Applicant has added claim 11 and its dependent claim 12-20. The Applicant submits that each of the claims 11, 15, and 16 contains subject matter of each of the original claims 1, 5, and 6, respectively, and the subject matter fully supported by the original Figures 4-6 and 9-10. Meanwhile, claims 12-14 and 17-20 contains subject matter supported by the original claims 2-4 and 7-10. As such, the newly added claims 11-20 contains no new matter, and the Applicant respectfully requests entry of the claims 11-20.

The Applicant wishes to thank the Examiner for indicating that any one of claims 2, 6, 8, and 9 would be allowed if any one of the claims is rewritten as an independent claim incorporating all features of the base and intervening claims. The Applicant believes that claim 1, as amended, is patentable over Kurata, and the Applicant wishes to defer rewriting any one of the claims 2, 6, 8, and 9 at this time.

Claim 1 stand rejected under 35 U.S.C ' 102(b) as allegedly being anticipated by Kurata (U.S. 5,633,962).

Claim 1 recites a directional coupler “wherein the light source and the photodetector are connected to one of the first and second waveguides, respectively.” The support for the direction coupler recited in claim 1 may be found in the previously presented claim 1; in the specification, at page 19, line 10-15, and at page 20, line 9-13; and in FIG. 9 and 10 (see light sources 413 and 513, and photodetectors 415 and 515).

According to the United States Court of Appeals for the Federal Circuit, a claim is anticipated **only if a single prior art reference set forth all features recited in a claim**

(*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)), **including those in functional language** (*In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ.2d 1429 (Fed. Cir. 1997) (holding that the patent applicant is free to recite features of an apparatus claim in functional language as long as the features are not inherent to the prior art)).

Kurata, as read by the Applicant, discloses a conventional light transmitting/receiving apparatus for bidirectional light transmission. However, Kurata does not disclose “the light source and the photodetector [] connected to one of the first and second waveguides, respectively,” as recited in claim 1 (FIG. 1). Instead, Kurata discloses a first waveguide connected to the light source 36, and a second waveguide connected to a reflective film 35 and a light receiving element 37.

Accordingly, Kurata does not set forth each and every feature of claim 1 and, in the process, Kurata does not anticipate claim 1. Claim 1 is, thus, patentable over Kurata, and the Applicant respectfully requests withdrawal of the rejection on claim 1.

In addition to claim 1, the Applicant believes that the newly added claim 11 is also patentable over Kurata. As such, the Applicant respectfully requests entry and allowance of the newly added claim 11.

Claim 11 recites “**a second dummy waveguide having a first internally isolated end surface, [and] a first reflector coupled to a second end surface of the second dummy waveguide disposed away from the internally isolated end surface.**” The support for the second dummy waveguide having a first internally isolated end surface and second end surface disposed away from the reflector is supported by Figure 4-6.

According to the Office Action, the second dummy waveguide, as recited in present claim 11, is identical to, thus set forth by, the waveguide 41 disclosed in Kurata (present Office Action, page 2, paragraph 2).

The waveguide 41 allegedly identical to the second dummy waveguide of claim 11, however, does not contain a first internally isolating surface end and a second end coupled to the reflector. In particular, the end of the waveguide 41 disposed away from the reflector 35 is connected to an optical fiber 43 and, thus, not internally isolated.

Therefore, the bidirectional optical semiconductor optical semiconductor apparatus disclosed in Kurata does not set forth “**a second dummy waveguide having a first internally isolated end surface, [and] a first reflector coupled to a second end surface of the second dummy waveguide disposed away from the internally isolated end surface,**” as recited in claim 11. As such, Kurata does not anticipate claim 11 and claim 11 is patentable over Kurata. The Applicant respectfully requests allowance of claim 11.


Other claims in this application are each dependent on the independent claims 1 and 11 and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

Amendment  
Serial No. 10/692,343

Should the Examiner deem that there are any issues which may be best resolved by telephone, please contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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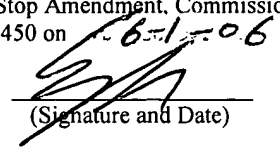
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